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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,882	12/24/2003	Masachika Masuda	501.39155VC2	9361

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EXAMINER

CLARK, SHEILA V

ART UNIT	PAPER NUMBER
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2815

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/743,882

Applicant(s)

MASUDA ET AL.

Examiner

S. V. Clark

Art Unit

2815

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Prelim-Amdt 4-20-2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/769359.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12-24-03, 4-22-04</u> | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2815

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 16-28 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kanemoto et al.

Kanemoto et al shows in for example figure 49, 50 a substrate 161 (i.e. wiring board) having a plurality of wires 162 on a main surface and having stacked chips 100 formed thereon comprising a first chip 112 (i.e. memory-flash (col. 21, line 58)) and a second chip 110 (i.e. control) (see col. 21, lines 49-60). Figure 51 shows first chip having first bond pads connected to first wires and second chip having second bond pads connected to second wires. Said wires are connected to said substrate via leads 101. Resin sealing 117 the assembly shown in figure 50.

Kanemoto et al fails to specifically provide specific structure relative to wiring board 161 but utilizes general terms suggesting it's obvious use as a typical wiring board having electrodes connected to wires 162 and which are typically connected to rear external terminal interconnection as is typical of wiring boards.

Figure 51 show no wire crossing and the second chip 110 is shown smaller than the first.

The claims contain method of making characteristics (i.e. polished to reduce thickness) having no patentable weight in determining the patentability of the final device structure.

Art Unit: 2815


Note that a "product by process" claim is directed to the product per se, no matter how actually made, In re Hirao 190 USPQ 15 at 17(footnote 3). See also In re Brown, 173 USPQ 685; In re Luck, 177 USPQ 523; In re Fessman, 180 USPQ 324; In re Avery, 186 USPQ 161 and In re Marosi et al, 218 USPQ 289, all of which make it clear that it is the patentability of the final product per se which must be determined in "product by process" claims, and not the patentability of the process, and that, as here, an old or obvious product produced by a new method is not patentable as a product, whether claimed in "product by process" claims or not.

Claims 16-28 are rejected.

Masuda et al, ('331, '663) and Ludwig et al are cited to show stacked chips with memories.

Applicant is also to note that the foreign references crossed out on the PTO-1449 were not available and if they are to be considered would have to be provided with the next office action with a new PTO-1449 containing just those references.

Any inquiry concerning this communication should be directed to S. V. Clark at telephone number (571) 272-1725.


S. V. Clark
Primary Examiner
Art Unit 2815

September 18, 2004